

*REMARKS*

The Office Action dated July 10, 2006 has been carefully considered. In the Office Action, all claims 1-27 were rejected and the Office Action was made Final. Considering that extensive prosecution has already occurred, that Applicant previously made targeted amendments to avert the prior art rejections that were previously advanced, and that Applicant hopes to avoid the appeals process, Applicant respectfully requests the Examiner to carefully consider the response and comments below. Applicant further requests the Examiner to give the Applicant a telephone call if it appears that in light of the below comments, the application may be close to condition for allowance, perhaps subject to some minor amendments. In any event, Applicant respectfully requests that the Examiner reply to the issues raised below so that at a minimum the record can be clarified for purposes of the appeals process. Applicant believes, however, the Examiner will find Applicant's further comments and information persuasive and will withdraw the rejections and issue a Notice of Allowance.

**35 U.S.C. §112 Rejection**

In the Office Action, claim 9 has been rejected under 35 U.S.C. §112 as failing to comply with the written description requirement with the addition of the phrase "composition is free of immiscible and insoluble topical composition particulates." The Office Action indicated that this feature is not taught in the disclosure, nor is it conventional knowledge to one of ordinary skill in the art.

It is axiomatic in the patent laws that each claim limitation must be expressly, implicitly, or inherently supported in the originally-filed disclosure but that there is "no *in haec verba* requirement" M.P.E.P. 2163I(B). Furthermore, the lack of literal basis in the specification may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1994).

The identified claim language is implicitly and inherently supported in the originally filed disclosure and one of ordinary skill in the art would have recognized from the specification that the limitation was supported by the specification. For something to be inherent it must necessarily flow from the teachings. *See Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Applicant previously identified that the examples disclosed in the specification provide support for the

amendment. See Applicant's Response dated March 30, 2006, Pg. 10, lls. 1-2. However, the Applicant will more fully explain below.

It is clear from the "Examples of the Invention" section of the originally-filed patent application to one of ordinary skill in the art that the specification provides support for a composition as claimed in claim 9 being "free of immiscible and insoluble topical composition particulates." For a specific example, Example 2 on page 13 of the original specification teaches an embodiment of a composition in accordance with the present invention that uses only three components, namely Triethylene glycol, Ethanol, and SM-96. The example teaches the percentage of each component of the composition in percentage by weight. Specifically, the example uses 10% of Triethylene glycol, TEG; 80% Ethanol, EtOH; and 10% SM-96, which one of ordinary skill in the art would recognize to equal 100% of the composition, or a complete listing of the components of the composition. As it is impossible to have a composition of more than 100% and all of these components are at least one of soluble and miscible, it immediately and necessarily follows that no other components, whether they be immiscible, insoluble, miscible, or soluble, may be added to or are included in the embodiment of the composition in Example 2. Therefore, the composition of Example 2 is free of immiscible and insoluble topical composition particulates.

Therefore, the amendment to claim 9 was fully supported by the specification in a way to convey to one of ordinary skill in the art that the inventor had possession of the claimed invention at the time of filing the application. As such, the applicant respectfully solicits the Examiner to withdraw the 35 U.S.C. § 112 rejection as it relates to claim 9.

However, if it pleases the Examiner and places the application in condition for allowance, the Applicant is willing to amend claim 9 to make the objected to language conform to the similar language of claim 1, which is clearly supported by the originally filed specification, particularly by the examples in the originally specification. If it will expedite the resolution of this issue, the Examiner is invited to contact the undersigned below for a further discussion.

**35 U.S.C. 102(e) Rejections**

It is axiomatic in the patent law that to reject a claim under 35 U.S.C. §102, each and every limitation must be found, expressly or inherently, in a single reference and arranged as required by the claims such that the reference discloses the identical invention. See MPEP §2131.

Rabe does not teach each and every limitation of the invention as claimed. Specifically, Rabe does not teach a composition in which all of the components of the composition are at least one of soluble or miscible. The Examiner has misread the boiler plate statements in Rabe that "all combinations of such embodiments and features are possible" (col. 2, lines 55-58) to mean "all combinations of the components of the embodiments are possible." The language in Rabe does not teach that essential elements of the embodiments may be removed from or absent from the embodiments of the disclosed compositions. Specifically, the Examiner specifically reads out of the teachings of Rabe that all embodiments must include "a particulate material which is insoluble and immiscible in the composition." The Summary of the Invention section specifically requires this component. (Column 2, Lines 21-22). The Detailed Description of the Invention section specifically requires this component. (Column 3, Lines 30-31).

Furthermore, Rabe states that "[t]he compositions also comprise a total of from about 0.1% to about 35% of one or more powder materials, which are generally defined as dry, particulate matter." (Column 6, Lines 21-23). By stating that "the compositions also comprise" the particulate matter, Rabe teaches that the compositions must include the particulate matter. The use of comprise allows other components to be included but does not permit the exclusion of that component for the solutions. Rabe does not teach that the compositions may optionally include the particulate matter, nor does it teach that an embodiment includes the particulate matter, nor does it teach that an embodiment does not include the particulate matter (i.e the powder material). Rabe teaches that "the compositions ... comprise" the particulate matter.

Furthermore, Rabe specifically identifies and discusses each of the required components of the compositions under their own headings. See Column 4, Line 12 ("Liquid Insulating Material"); Column 5, Line 14 ("Conductive Material"); Column 6, Line 20 ("Powder Component"); Column 7, Line 21 ("Thickening Agents"); Column 8, Line 51 ("Optional Components"). The insoluble and immiscible particulate

matter is specifically discussed under the "Powder Component" section of Rabe rather than the "Optional Components" section of Rabe.

As such, Rabe does not teach any compositions that are made entirely of soluble and miscible components. The Examiner has improperly ignored and read out of the claim the limitation that "all" components are at least one of soluble and miscible, improperly making the "all" superfluous. Because Rabe does not teach each and every limitation of claim 1, Rabe does not anticipate the invention as claimed in claim 1. The Examiner is therefore respectfully solicited to withdraw the rejection to claim 1 and claims that depend therefrom.

Independent claim 9 recites, *inter alia*, "the electrostatically dispensable disinfectant composition is free of immiscible and insoluble topical composition particulates." As discussed previously, Rabe does not disclose any embodiments that are formed of entirely miscible and/or soluble components, let alone a composition that does not include "immiscible and insoluble topical composition particulates." Therefore, Rabe does not teach each and every limitation of the invention as claimed in claim 9. The Applicant respectfully solicits the Examiner to withdraw the rejection to claim 9 and claims that depend therefrom.

### **Obviousness Issues**

Considering the secondary references do not cure the deficiencies of Rabe, the obviousness rejections should also fall.

### **Summary of Inherency Law**

Applicant is quite cognizant of the principle of inherency and has articulated why the claims are allowable with this standard in mind. For ready reference, a short summary is provided below which readily shows that inherency cannot be applied to Rabe in making an anticipation rejection.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9

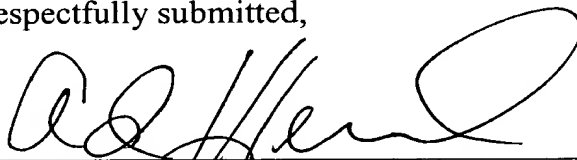
In re Appln. Of: Claudio L.K. Lins  
Application No.: 09/766,730

F.ed 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherency necessarily flows from the teachings of the applied prior art. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter 1990). M.P.E.P. 2112 IV.

**Conclusion**

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A. J. Heinisch', written over a horizontal line.

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Date: September 6, 2006